



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO. /	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,422	02/07/2002	Jian Ni	PT004P1C1	8521

22195 7590 03/25/2003

HUMAN GENOME SCIENCES INC
9410 KEY WEST AVENUE
ROCKVILLE, MD 20850

EXAMINER

ANDRES, JANET L

ART UNIT PAPER NUMBER

1646

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,422

Applicant(s)

NI ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO: 2 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
2. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO:3 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
3. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO: 7 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
4. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO: 4 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
5. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO: 5 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
6. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO: 6 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.

Art Unit: 1646

7. Claims 1-10, 14, and 15, drawn to the polynucleotides of SEQ ID NO: 8 and means of expression, classified in class 435, subclass 69.1, 320.1, and 325, and class 536, subclass 23.5.
8. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 9, classified in class 530, subclass 350.
9. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 10, classified in class 530, subclass 350.
10. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 14, classified in class 530, subclass 350.
11. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 11, classified in class 530, subclass 350.
12. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 12, classified in class 530, subclass 350.
13. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 13, classified in class 530, subclass 350.
14. Claims 11, 12, and 16, drawn to polypeptides of SEQ ID NO: 15, classified in class 530, subclass 350.
15. Claim 13, drawn to antibodies against SEQ ID NO: 9, classified in class 530, subclasses 388.1 and 389.1.
16. Claim 13, drawn to antibodies against SEQ ID NO: 10, classified in class 530, subclasses 388.1 and 389.1.

Art Unit: 1646

17. Claim 13, drawn to antibodies against SEQ ID NO: 14, classified in class 530, subclasses 388.1 and 389.1.
18. Claim 13, drawn to antibodies against SEQ ID NO: 11, classified in class 530, subclasses 388.1 and 389.1.
19. Claim 13, drawn to antibodies against SEQ ID NO: 12, classified in class 530, subclasses 388.1 and 389.1.
20. Claim 13, drawn to antibodies against SEQ ID NO: 13, classified in class 530, subclasses 388.1 and 389.1.
21. Claim 13, drawn to antibodies against SEQ ID NO: 15, classified in class 530, subclasses 388.1 and 389.1.
22. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 9, classified in class 424, subclass 198.1
23. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 10, classified in class 424, subclass 198.1
24. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 14, classified in class 424, subclass 198.1
25. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 11, classified in class 424, subclass 198.1
26. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 12, classified in class 424, subclass 198.1
27. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 13, classified in class 424, subclass 198.1

Art Unit: 1646

28. Claim 17, drawn to methods of treatment with the polypeptide of SEQ ID NO: 15, classified in class 424, subclass 198.1
29. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO: 2, classified in class 424, subclass 9.1.
30. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO:3 classified in class 424, subclass 9.1.
31. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO: 7 classified in class 424, subclass 9.1.
32. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO:4 classified in class 424, subclass 9.1.
33. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO: 5 classified in class 424, subclass 9.1.
34. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO: 6 classified in class 424, subclass 9.1.
35. Claim 18, drawn to diagnosis using the polynucleotides of SEQ ID NO:8 classified in class 424, subclass 9.1.
36. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO: 9, classified in class 424, subclass 9.34.
37. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO:10, classified in class 424, subclass 9.34.
38. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO: 14, classified in class 424, subclass 9.34.

Art Unit: 1646

39. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO:11, classified in class 424, subclass 9.34.
40. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO: 12, classified in class 424, subclass 9.34.
41. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO: 13 classified in class 424, subclass 9.34.
42. Claim 19, drawn to diagnosis using the polypeptide of SEQ ID NO:15, classified in class 424, subclass 9.34.
43. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO: 9, classified in class 435, subclass 7.1.
44. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO:10, classified in class 435, subclass 7.1.
45. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO: 14, classified in class 435, subclass 7.1.
46. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO:11, classified in class 435, subclass 7.1.
47. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO: 12, classified in class 435, subclass 7.1.
48. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO: 13 classified in class 435, subclass 7.1.
49. Claims 20 and 21, drawn to screens using the polypeptide of SEQ ID NO:15, classified in class 435, subclass 7.1.

Art Unit: 1646

50. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO: 2, classified in class 435, subclass 455.
51. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO:3 classified in class 435, subclass 455.
52. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO: 7 classified in class 435, subclass 455.
53. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO:4 classified in class 435, subclass 455.
54. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO: 5 classified in class 435, subclass 455.
55. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO: 6 classified in class 435, subclass 455.
56. Claim 22, drawn to treatment using the polynucleotides of SEQ ID NO:8 classified in class 435, subclass 455.

Claims appear in more than one group if they encompass more than one invention.

The inventions are distinct, each from the other because of the following reasons:

The polynucleotides of Inventions 1-7 are different, each from the other, because they have different sequences and thus different structures.

The polynucleotides of Inventions 1-7 are not related to the polypeptides of Inventions 8-

14. They have different structures and different functions, and cannot be used together or interchangeably.

Art Unit: 1646

The polynucleotides of Inventions 1-7 are not related to the antibodies of Inventions 15-21. They have different structures and different functions, and cannot be used together or interchangeably.

The polynucleotides of Inventions 1-7 are not related to the methods of Inventions 22-28. They cannot be used in these methods.

The polynucleotides of Invention 1-7 are distinct from the methods of Inventions 29-35 because they have other uses, such as the generation of protein.

The polynucleotides of Inventions 1-7 are not related to the methods of Inventions 36-42. They cannot be used in these methods.

The polynucleotides of Inventions 1-7 are not related to the methods of Inventions 43-49. They cannot be used in these methods.

The polynucleotides of Invention 1-7 are distinct from the methods of Inventions 50-56 because they have other uses, such as the generation of protein.

The polypeptides of Inventions 8-14 are different, each from the other, because they have different sequences and thus different structures.

The polypeptides of Inventions 8-14 are not related to the antibodies of Inventions 15-21. They have different structures and different functions, and cannot be used together or interchangeably.

The polypeptides of Inventions 8-14 are distinct from the methods of Inventions 22-28. They have other uses, such as the generation of antibodies.

The polypeptides of Inventions 8-14 are not related the methods of Inventions 29-35. They cannot be used in these methods.

Art Unit: 1646

The polypeptides of Inventions 8-14 are distinct from the methods of Inventions 36-42.

They have other uses, such as the generation of antibodies.

The polypeptides of Inventions 8-14 are distinct from the methods of Inventions 43-49.

They have other uses, such as the generation of antibodies.

The polypeptides of Inventions 8-14 are not related the methods of Inventions 50-56.

They cannot be used in these methods.

The antibodies of Inventions 15-21 are different, each from the other, because they have different sequences and thus different structures.

The antibodies of Inventions 15-21 are not related to the methods of Inventions 22-28.

They cannot be used in the methods.

The antibodies of Inventions 15-21 are not related to the methods of Inventions 29-35.

They cannot be used in the methods.

The antibodies of Inventions 15-21 are not related to the methods of Inventions 36-42.

They cannot be used in the methods.

The antibodies of Inventions 15-21 are distinct from the methods of Inventions 43-49.

They can be identified in other ways, such as by Western blotting.

The antibodies of Inventions 15-21 are not related to the methods of Inventions 50-56.

They cannot be used in the methods.

The methods of Inventions 22-28 are distinct, each from the other, because they require proteins with different sequences and thus different structures; they therefore require different reagents.

Art Unit: 1646

The methods of Inventions 22-28 are not related to the methods of Inventions 29-35.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 22-28 are not related to the methods of Inventions 36-42.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 22-28 are not related to the methods of Inventions 43-49.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 22-28 are distinct from those of Inventions 50-57. They require different reagents and different method steps.

The methods of Inventions 29-35 are distinct, each from the other, because they require polynucleotides with different sequences and thus different structures; they therefore require different reagents.

The methods of Inventions 29-35 are distinct from those of Inventions 36-42. They require different reagents and different method steps.

The methods of Inventions 29-35 are not related to the methods of Inventions 43-49.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 29-35 are not related to the methods of Inventions 50-56.

They have different goals and outcome measures and require different reagents and method steps.

Art Unit: 1646

The methods of Inventions 36-42 are distinct, each from the other, because they require polypeptides with different sequences and thus different structures; they therefore require different reagents.

The methods of Inventions 36-42 are not related to the methods of Inventions 43-49.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 36-42 are not related to the methods of Inventions 50-56.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 43-49 are distinct, each from the other, because they require polypeptides with different sequences and thus different structures; they therefore require different reagents.

The methods of Inventions 43-49 are not related to the methods of Inventions 50-56.

They have different goals and outcome measures and require different reagents and method steps.

The methods of Inventions 50-56 are distinct, each from the other, because they require polynucleotides with different sequences and thus different structures; they therefore require different reagents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1646


Because these inventions are distinct for the reasons given above and the searches required for the different groups are different, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres, whose telephone number is 703-305-0557. The examiner can normally be reached on 8:00-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Janet L. Andres, Ph.D
Patent Examiner

March 24, 2003